

Appl. No. 09/880,266  
Amdt. Dated December 2, 2005  
Reply to Office action of October 5, 2005  
Attorney Docket No. P14976-US2  
EUS/J/P/05-3313

### **REMARKS/ARGUMENTS**

#### **Claim Amendments**

Claims 1-7 and 9-14 are pending in the application. Favorable reconsideration of the application is respectfully requested in view of the foregoing amendments and the following remarks.

#### **Claim Rejections - Double Patenting**

Claims 1-7 and 9-14 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 24 of Valentine et al. (U.S. Patent No. 6,356,751) (hereinafter '751) in view of Choi et al (U.S. Patent No. 6,594,492 B2) (hereinafter '492). The present application and U.S. Patent No. 6,356,751 and U.S. Patent No. 6,594,492 B2 are commonly owned by the Assignee, Telefonaktiebolaget LM Ericsson (publ). An assignment, which assigns ownership to the Assignee of U.S. Patent No. 6,356,751 and all continuing applications, was recorded in the USPTO on June 24, 1999, at reel/frame 010065/0607 and, an assignment, which assigns ownership to the Assignee of U.S. Patent No. 6,594,492 B2 and all continuing applications, was recorded in the USPTO on July 6, 1999, at reel/frame 010074/0044.

The Applicants have filed a Terminal Disclaimer herewith to overcome this rejection. An authorization to charge Deposit Account No. 50-1379 for the Terminal Disclaimer fee under 37 C.F.R. 1.20(d) is enclosed.

#### **Claim Rejections – 35 U.S.C. § 103 (a)**

Claims 1, 9 and 13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Bilder (US Patent No. 6,292,542 B1, hereinafter "Bilder") in view of Garin, et al. (US Patent No. 6,671,620 B1, hereinafter "Garin"). The Applicant respectfully traverses the rejection of these claims.

The Bilder reference appears to disclose a method and apparatus for handling an in-call request for emergency services in a wireline telecommunications network. Emergency services can be requested during an ongoing call and the requester can be

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bridged to an emergency services operator or the call can be terminated and the requester can be connected to the operator. Bilder discloses an interexchange (IXC) that recognizes the request through either voice recognition, or DTMF tones generated by a key or set of keys. The IXC accesses an emergency number database and routes the requesting party to the emergency services. (Summary)

The Garin reference appears to disclose a global positioning system that uses satellite almanac data to predict satellite position and provide a cellular telephone user's location within 10 seconds. A Position Determining Entity (PDE) communicates with a satellite to receive almanac data and stores the data in memory. The data is then used to compute geographical location using the most recently acquired data. (Fig. 1, Col. 3, lines 43-52)

The Applicant respectfully directs the Examiner's attention to independent claim

1.

1. (Previously Presented) A method of managing an Emergency Services Call (ESC) within a mobile network while a subscriber is engaged in an on-going call, wherein the network includes a serving entity, an anchor entity, a Position Determination Entity (PDE), and an Emergency Services Entity (ESE), the method comprising the steps of:

handing off the on-going call from the anchor entity to the serving entity;

responsive to an emergency condition, the subscriber invoking the ESC via 3-way calling while maintaining the on-going call;

receiving a request for the ESC at the serving entity;

receiving a request for a current geographic position of the subscriber at the PDE;

determining the current geographic position of the subscriber by the PDE;

receiving the current geographic position of the subscriber at the serving entity;

sending the current geographic position to the anchor entity;

setting up the ESC between the anchor entity and the ESE, wherein the current geographic position is included in the call setup message; and

updating the anchor entity with the current geographic position.(emphasis added)

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The Applicant respectfully submits that the emphasized portions of claim 1 are not taught by Bilder or Garin or a combination of Bilder and Garin.

In the Detailed Action, a correspondence is drawn between the LEC and IXC in the Bilder reference and "a serving MSC and an anchor MSC" in the Applicant's application. The Detailed Action states, "...the network includes a LEC and an IXC, which reads on claimed serving entity and an anchor entity". The Applicant respectfully submits that the LEC and IXC do not read on the serving and anchor entities.

When a long distance call is placed in a wireline network, a LEC and an IXC are both serving the call at the same time. In a wireless network, when a mobile terminal places a call an anchor Mobile Switching Center (MSC) is the switch where a call is initially placed. If the mobile terminal moves to a geographical service area of a second MSC, that second MSC becomes the serving MSC. The anchor MSC remains connected, but leaves much of the control of the call, especially the control of the radio access network, to the serving MSC. After a handoff, the anchor MSC has no direct contact with the mobile terminal. In direct contrast in the wireline network, the LEC does not hand off the call to an IXC. The LEC remains as the first, direct contact to the calling user terminal.

As the mobile user moves, an inter-system handoff may occur. A new serving MSC would then serve the mobile call as described above. As is known in the art, handoff is a process that only refers to mobile calls. As a call is handled at the same time by a LEC or a mobile exchange and an IXC, there is no handoff, i.e. transfer of the control of the call from the LEC (or MSC) to the IXC.

In the Applicant's invention the serving MSC is different from the anchor MSC. The serving MSC may receive, from the mobile terminal, an emergency call set up request after an inter-MSC handoff. In Bilder, the LEC is always connected to the user terminal so it receives the emergency call set up request directly from the user terminal. In the Bilder reference, the user terminal is fixed, so its geographical position is already known. In the Applicant's invention, the terminal is a mobile terminal so the mobile terminal position is continually being checked and there is a necessary step of locating the current position of the mobile terminal. So, geographical position in Bilder (col. 4,

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lines 39-52) is useful for selecting the most appropriate response to an emergency call.

The Bilder reference teaches that the location of the communication device of the Bilder reference is provided by the device user. (Col. 5, lines 40-50) The difference between Bilder and the Applicant's invention is that a procedure for locating the current position of the mobile terminal is done by a position determining entity, while the location of the Bilder device is provided by one of the called or calling party.

The 'Response to Arguments' on page 5 of the Detailed Action notes that Bilder discloses that the claimed invention can also be implemented in a wireless environment. In this cited portion of the Bilder reference, communication services can be performed by, among other systems "...wired and/or wireless communications systems...", and the calling and called parties can use "...wired and wireless telephones, cellular telephones..." (Col. 5, lines 58-65). The Applicant respectfully submits that the cited portion refers to including the various examples of communication means in the connection between the called and calling party. In other words, the Bilder invention works even when wireless devices connect through the IXC and LECs, not that the invention of Bilder can be implemented in a wireless network.

Furthermore, a general statement that a particular invention can also be accomplished in another medium, without an accompanying enabling disclosure, should not be grounds for rejection. The Bilder reference particularly leaves out critical elements that would be necessary for the Bilder system and method to operate in a wireless network. For instance, Bilder does not teach that the wireless network mentioned in the Detailed Description performs handoff of a mobile terminal from an anchor Mobile Switching Center (MSC) to a serving MSC. Also, Bilder does not teach sending a new geographic position of a terminal for updating the mobile terminal geographic position information at an anchor entity (MSC), as claimed in the Applicant's invention. In particular, since the communication devices of Bilder are not described or defined as roaming communication devices, Bilder does not disclose steps for determining the current position of a subscriber during an emergency call setup after a handoff of an ongoing call, as claimed by the Applicant. The Bilder reference merely

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describes geographical location of emergency services in relation to the geographic location of the requester.

Additionally, the Bilder communication devices do not roam from a first LEC to a second LEC thus, resulting in a call setup in the second LEC. As stated in Bilder, a request for emergency services for a second user of a second communication device during a call may be sent to the LEC of the second user. Thus, the Bilder reference teaches away from a three-way call establishment after a handoff as claimed in the Applicant's invention.

Regarding claims 1, 9 and 13, the prior art of record Bilder and Garin, taken alone or in combination, fails to disclose or render obvious at least handing off an mobile terminal ongoing call from an anchor entity to a serving entity (both defined in the specification as types of Mobile Switching Centers – page 3, lines 4-8). Nor does either Bilder or Garin teach sending a current geographic location of the mobile terminal to the serving entity and forwarding that position to the anchor entity.

The Applicant respectfully requests the withdrawal of the rejection of independent claims 1, 9 and 13. Additionally, since the dependent claims contain the subject matter of the independent claims, the withdrawal of the rejection of all the claims depending from the respective independent claims is also respectfully requested.

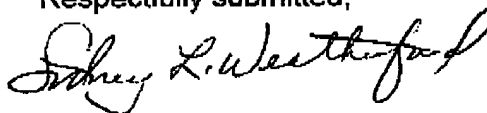
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### CONCLUSION

In view of the foregoing remarks, the Applicant believes all of the claims currently pending in the Application to be in a condition for allowance. The Applicant, therefore, respectfully requests that the Examiner withdraw all rejections and issue a Notice of Allowance for all pending claims.

The Applicant requests a telephonic interview if the Examiner has any questions or requires any additional information that would further or expedite the prosecution of the Application.

Respectfully submitted,



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Date: December 2, 2005

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